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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,063	05/29/2001	Ralph Rhein	CLR-103US	5733

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JANSSON, SHUPE & MUNGER, LTD  
245 MAIN STREET  
RACINE, WI 53403

EXAMINER
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DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/867,063

Applicant(s)

RHEIN, RALPH

Examiner

Tamra L. Dicus

Art Unit

1774

-- Th MAILING DATE of this communication app ars on th cov r sheet with th correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 32-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

The 112 rejections are withdrawn. The IDS is acknowledged, paper no. 4.

### *Claim Objections*

1. Claim 45 is objected to because of the following informalities: "low tack" should be hyphenated as in disclosure. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 45 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. From the disclosure, the low-tack property is to the adhesive, and not to the backing layer surface, as in the instant claim. Hence, it is conflicting.

4. Claim 56 refers to adhesive being "printed" onto the image. This does not make sense. The Examiner cannot understand what Applicant intends. Clarification is requested.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 32-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,143,407 to Lythgoe et al. in view of USPN 6,423,406 to Bilodeau and USPN 6,080,261 to Popat et al.
7. Lythgoe teaches a flexible dry transfer sheet comprising referring to the drawing, a flexible carrier sheet 1 of heat resistant polymer film such as polyester is preferably transparent or translucent and is coated with an adherent thin release layer 2. On the surface of the release layer one or more indicium or other design 5 is printed in a heat-fused plastisol ink. Coated over the indicium 5 and extending over the surface of the release layer is a coating of a pressure sensitive adhesive 3. This adhesive has an intrinsically low tack so that it forms a bond of low strength with a substrate. See col. 5, lines 60-68 and col. 6, line 1. Also see Example 1 and Figure 1. Lythgoe teaches a transfer label teaching acrylics are PSAs at col. 7, lines 7-8. Meeting limitations of claims 43, 44, 47, 56, and 59.
8. Lythgoe teaches a release layer on the carrier (col. 9, lines 60-68), the release layer acts as a functional equivalent to transferring graphics substrate-free, therefore claims 32 and 50 are taught.
9. Lythgoe does not teach printing in a multiple number of ink layers and "picture quality". However, Bilodeau teaches a graphic transfer sheet. At col. 2, lines 31-35, inks are printed in a number of ink layers, inherently providing "picture quality" since the same materials are taught (meeting new claims 48, 49, 60, and 61). Hence, it would have been obvious to one of ordinary skill in the art to modify the sheet of Lythgoe to further include multiple inks since Bilodeau teaches providing multiple inks as a design.

10. Lythgoe does not state the combined thickness of less than 5 mils (claims 39, 41, 52, and 53). However, it would have been obvious to one of ordinary skill in the art to produce a thickness less than 5 mils, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The thickness directly effects the coating weight.
11. Regarding claim 36, the Examiner takes the position that the polyester is smooth since it is a film and does not have any printing or punctures on it. Further the reference does not teach that the film has any roughness value.
12. Regarding claims 37 and 38, while Lythgoe does not explicitly state the degree of strength of the release coating, it is more than obvious the release coating adheres to the polyester substrate/film since the transfer portion is what is being transferred to the glass, hence the term "transfer". See further col. 6, lines 1-10 and lines 50-61 teaching an equivalent transfer. Moreover, the act of removing/separating is a process limitation in a process claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Further regarding the new limitation on "adapted to adhere..." of claim 37 and 38, the phrase "adapted to adhere" is indefinite, as the phrase does not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.

Regarding claims 39-41 and 52-54, the thicknesses of the image, adhesive layer, and release-finish coating is not taught by Lythgoe. However, Popat teaches an adhesive image transfer where an image is in an adhesive layer having a thickness between 0.5 and 2 mils, a release coating is 0.1 mils (col. 4, lines 1-13), see also col. 6, lines 55-63, totaling to a thickness range less than 3 and/or 5 mils. Hence it would have been obvious to one of ordinary skill in the art to produce a thickness less than 3/5 mils, since it Popat teaches it is conventional to do so at col. 4, lines 1-13 and col. 6, lines 55-63.

Regarding the properties of the PSA being "mutually insoluble" and "low-tack" of claims 45, 46, 57, and 58, such properties are inherent as the same materials are taught.

#### ***Response to Arguments***

13. Bilodeau is used to teach applying multiple inks and hence still used. Lythgoe is now used to teach the laminate structure. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus  
Examiner  
Art Unit 1774

June 24, 2003

~~CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700~~

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

*Cynthia H. Kelly*